

Remarks/Arguments

Claims 1-7 and 20 have been canceled. Claims 8-19, 21-28 and 30-34 have been withdrawn. Claims 29 and 35-45 are currently pending and are under examination. The applicants reserve the right to pursue, in this or related applications, claims directed to any unclaimed or canceled subject matter whether originally claimed, later claimed, or not previously claimed. Further discussion of the claim amendments is provided herein.

The applicants thank the examiner for allowing Groups IV and V to be rejoined to the elected Group I when the latter group is found to be allowable.

I. Amendments

Claims 29, 40, 42 and 43 are presently amended in the application. Support for the amendments to the claims are found throughout the specification, including pages 19-20. Accordingly, the amendments do not include new matter.

II. Objections

The objection of Claim 20 is moot as the claim has been canceled. Claim 40 has been amended by adding "wherein" as suggested by the examiner.

III. Rejections

A. The examiner rejected Claim 40 under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicants regard as their invention. In response, the applicants submit that the rejection has been rendered moot by amendment.

B. The examiner rejected Claim 43 under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicants regard as their invention. In response, the applicants submit that the rejection has been rendered moot by amendment.

C. The examiner rejected Claims 29, 42 and 43 under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. The examiner alleged that, regarding Claim 29, the applicants did not have possession of the claimed invention because the specification fails to identify any fragments of GID that binds GNK and sGNK. Regarding Claim 42, the examiner alleged that the claim lacks a written description of a polypeptide that is not cleavable by caspase-3, because, according to the examiner, "teaching only one representative species of the genus [GID fragment lacking residues 581-584]

does not provide a sufficient identifying structural characteristics of the claimed subgenera [GID polypeptides that are not cleavable by caspase-3].” (page 6)

In response, the applicants respectfully submit that Claims 29, 42 and 43 meet the requirement under 35 U.S.C. § 112, first paragraph. Regarding the rejection of Claim 29, the applicants teach a GID polypeptide comprising SEQ ID NO: 2 and fragments of GID that are capable of binding to GNK and/or sGNK. See pages 6-7. The applicants thus believe that they had possession of the claimed invention at the time of the original filing. Withdrawal of this rejection is respectfully requested.

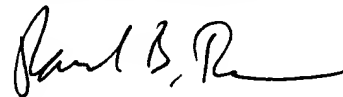
Regarding the rejection of Claims 42 and 43, the applicants respectfully submit that they have provided sufficient written description for the invention as claimed, in particular, a GID polypeptide that is not cleavable by caspase-3. First, the applicants have disclosed in the instant specification the cleavage site for caspase-3 within the GID polypeptide (see page 55, lines 12-14). Second, the applicants have provided an example of such polypeptide, as the examiner acknowledges in the rejection. (The cleavage site as disclosed contains amino acid residues DNVD, which are numbered as residues 581-584 of SEQ ID NO: 2.) Thus the applicants respectfully submit that in view of the teaching of the caspase-3 site embedded within GID and a GID polypeptide that is not cleavable by caspase-3, the applicants have met the written description requirement. According to the USPTO's Synopsis of Application of Written Description Guidelines, published online at <http://www.uspto.gov/web/menu/written.pdf>, when examining claims drawn to sequence, the examiner should weight all factors, including the teaching of the sequence and variability of the sequence, in view of the level of knowledge and skill in the art. See Example 8 of the guidelines. The applicants submit that one skilled in the art would recognize from the disclosure that a GID polypeptide that is not cleavable by caspase-3 does not contain this cleavage site or that contains a mutation within the site, e.g., an amino acid substitution and/or deletion, as the applicants have instantly disclosed. Further, as changing specific amino acid residue(s) within a given sequence is a routine experimentation in the art, the applicants submit that the experimentation is not an undue burden to the artisan. Withdrawal of this rejection is respectfully requested.

D. The examiner rejected Claims 20, 29, 35-42 and 44 under 35 U.S.C. § 102(e) as allegedly anticipated by WO 01/53312 A1. Reconsideration under 37 CFR 1.111 is requested. In response to this rejection, the applicants submit herewith a Rule 131 Declaration signed by all the inventors. The declarants describe the nucleic acid and amino acid sequences of human GID prior to July 19, 2000, the priority date of the WO publication. Accordingly, the applicants submit that they have broadly established a completion of an embodiment of the invention prior to the date of the cited reference. In view of the 131 Declaration, the applicants respectfully request the examiner to withdraw this rejection. The Declaration notwithstanding, the applicants wish to point out that WO 01/53312 A1 does not teach the presence of a caspase-3 cleavage site with the GID polypeptide. Hence it does not anticipate the subject matter recited in claims 42 and 43.

E. The examiner rejected Claim 45 under 35 U.S.C. § 103 as being allegedly unpatentable over WO 01/53312 A1 in view of "common knowledge in the field of biotechnology." Reconsideration under 37 CFR 1.111 is requested. The applicants respectfully request the examiner to withdraw this rejection because the primary and sole reference is not a proper reference under 35 USC § 102 or § 103. As presented in the response to the § 102(e) rejection above, the reference has been antedated by the applicants' 131 Declaration.

Applicants respectfully request that a timely Notice of Allowance be issued for this case.

Respectfully submitted,



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